

Applicants: Isabelle Mansuy and Eric R. Kandel  
U.S. Serial No.: 10/091,714  
Filed: March 5, 2002  
Page 5

**REMARKS**

Claims 1, 2, 4-6, 8-10, 21-23, 25-27, 29 and 30 are pending in the subject application. Applicants have herein canceled claims 10 and 22 without prejudice to applicants' right to pursue the subject matter of these claims in the future. In addition, applicants have amended claims 1, 2, 4-6, 8, 9, 21, 23, 25-27, 29 and 30. Support for the amendments to claim 1 may be found in the specification at, *inter alia*, page 15, lines 14-21; page 15, line 26; page 16, line 3; page 12, lines 1-10; and page 16, lines 10-11. Support for the amendments to claims 2, 4-6, 8 and 9 may be found in the specification at, *inter alia*, page 16, lines 10-11. Support for the amendments to claim 21 may be found in the specification at, *inter alia*, page 17, lines 20-28; page 12, lines 1-10; and page 15, lines 10-12. Claims 23, 25-27, 29 and 30 have been amended merely to change the phrase "composition of matter" to "composition." Applicants maintain that the amendments to the claims raise no issue of new matter. Accordingly, applicants respectfully request entry of this Amendment. Upon entry of this Amendment, claims 1, 2, 4-6, 8, 9, 21, 23, 25-27, 29 and 30 will be pending and under examination.

**35 U.S.C. §112, First Paragraph (Written Description)**

The Examiner rejected claims 21-23, 25-27, 29 and 30 under 35 U.S.C. §112, first paragraph, as allegedly not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The Examiner stated that the claims are directed to "a nonhuman composition of matter" and alleged that the specification as filed does not contemplate "a nonhuman composition of matter."

Applicants: Isabelle Mansuy and Eric R. Kandel  
U.S. Serial No.: 10/091,714  
Filed: March 5, 2002  
Page 6

In response, applicants respectfully traverse the Examiner's rejection. However, in order to expedite prosecution, and without conceding the correctness of the Examiner's position, applicants have herein amended claim 21, from which claims 23, 25-27, 29 and 30 depend, to remove the term "nonhuman" objected to by the Examiner. Applicants note that claim 22 has been cancelled herein. Applicants also note that the term "nonhuman" was previously added to claim 21 by applicants in response to the Examiner's understanding that "a composition of matter" encompasses humans. Nevertheless, applicants have amended claim 21 to remove this term. Applicants maintain that the claims as amended do not encompass human beings. Accordingly, applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection.

**35 U.S.C. §112, First Paragraph (Enablement)**

The Examiner rejected claims 1, 2, 4-6, 8-10, 21-23, 25-27, 29 and 30 under 35 U.S.C. §112, first paragraph, as allegedly not enabled by the specification. The Examiner stated that "other than the enhanced expression of the calcineurin inhibitor protein, the claimed mammals include those that exhibit a wild-type phenotype." The Examiner also alleged that the specification "does not teach how to use a mammal that exhibits enhanced expression of a calcineurin inhibitor protein as now claimed."

In response, applicants respectfully traverse the Examiner's rejection. First, with regard to claims 1, 2, 4-6, 8 and 9, and contrary to the Examiner's position, applicants note that wild-type animals do not include transgenic animals, and specifically do not include transgenic animals exhibiting enhanced calcineurin inhibitor protein expression on induction of a transcriptional activator. Moreover, it is not relevant to the question of

Applicants: Isabelle Mansuy and Eric R. Kandel  
U.S. Serial No.: 10/091,714  
Filed: March 5, 2002  
Page 7

enablement whether, in this case, the traits of the claimed transgenic mice - other than enhanced calcineurin inhibitor protein expression - are wild-type.

Second, the specification teaches how to make and use the claimed mice (see, for example, Figs. 1A, 1C and 1D, page 5, line 19, to page 6, lines 10; page 21, lines 15 to 22 regarding making the claimed mouse). Also, the specification teaches how to use the claimed mouse as an element in an assay for determining whether an agent inhibits Long Term Potentiation in a cell or a mammal. See, for example, the specification at page 3, line 29 to page 4, line 30; Fig. 2B; Fig. 3D; and page 25, line 1 to page 26, line 12.

Accordingly, applicants maintain that the specification teaches how to make and use the claimed invention. Thus, applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection.

With regard to claims 21-23, 25-27, 29 and 30, applicants maintain that the Examiner's arguments regarding enablement are overcome by applicants' amendment to claim 21 clarifying that the claim is directed to a composition comprising a nucleic acid vector and not to an animal. Accordingly, applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection.

**35 U.S.C. §112 (Second Paragraph)**

The Examiner rejected claims 21-23, 25-27, 29 and 30 as allegedly indefinite for reciting "wherein the nonhuman composition of matter exhibits enhanced calcineurin inhibitor protein expression on induction of the transcriptional activator", in that it is

Applicants: Isabelle Mansuy and Eric R. Kandel  
U.S. Serial No.: 10/091,714  
Filed: March 5, 2002  
Page 8

unclear how a composition of matter can express a protein.

In response, applicants respectfully traverse the Examiner's rejection. However, in order to expedite prosecution, and without conceding the correctness of the Examiner's position, applicants have herein amended claim 21, from which claims 22, 23, 25-27, 29 and 30 depend, to remove the language objected to by the Examiner. Accordingly, applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection.

Applicants: Isabelle Mansuy and Eric R. Kandel  
U.S. Serial No.: 10/091,714  
Filed: March 5, 2002  
Page 9

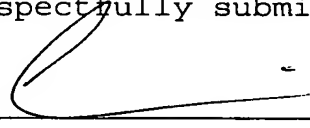
Summary

Applicants maintain that the pending claims as amended are in condition for allowance. Accordingly, allowance is respectfully requested.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorneys invite the Examiner to telephone them at the number provided below.

No fee is deemed necessary in connection with the filing of this Amendment. However, if any fee is required, authorization is hereby given to charge the amount of such fee to Deposit Account No. 03-3125.

Respectfully submitted,



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